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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Stephanie Parlamas

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AT & T Legal Department - WS

Attn: Patent Docketing

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EXAMINER

LEE, BRYAN Y

ART UNIT

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2445

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/828,950	Applicant(s) PARLAMAS ET AL.	
	Examiner BRYAN LEE	Art Unit 2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Remarks/Arguments

1. This communication is considered fully responsive to the Amendment filed on 04 May 2009.
2. Applicant's arguments filed 04 May 2009 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references involve making calls using Session Initiation Protocol or SIP which is widely used on IP networks.

In response to applicant's arguments, the recitation "setting up internet protocol network calls" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15

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(CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim(s) 1, 4, 7-9 and 11-14** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,406,168 B2 to *Celi, JR. et al.* ("*Celi*") in view of U.S. Pre-Grant Publication 2002/0194331 A1 to *Lewis et al.* ("*Lewis*").

As to **claim 1**, *Celi* disclose(s) a signaling method for use in setting up internet protocol network calls, wherein said internet protocol network comprises an application server for providing call feature processing, said method comprising the steps of:

receiving at an application server (*Celi*; Fig. 1; 105; Connection Server) call information (*Celi*; Fig. 4; call information request) whereby said application server is inserted into a signaling path for said call. (*Celi*; col. 8; ll. 12; communication path)

Celi do(es) not expressly disclose providing call feature processing including determining a primary and alternate routing number for said call.

Lewis disclose(s) determining primary and alternate destinations for a call.
(*Lewis*; [0053])

Celi and *Lewis* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the alternate destination aspect of *Lewis* with the method of *Celi*. The suggestion/motivation would have been to notify someone of an incoming call even if his/her primary address is busy. (*Lewis*; [0053])

Celi further discloses determining, at said application server, whether said application server is required in the signaling path to complete call setup for said call; and (*Celi*; Fig. 4; Step 460; if more resource need to be queried then the connection manager repeats the determination process as needed)

if said application server is not required in the signaling path to complete said call setup, said application server removing itself from the signaling path. (*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager can remove itself from the communication path")

As to **claim 4**, *Celi* further disclose(s) a method wherein, if said determining step determines that said application server is required in said signaling path to complete call setup, said method further comprising the steps of:

said application server providing feature processing for said call; and (*Celi*; processing services are provided through telephony resources 120 and 125; col. 4, ll. 4-16)

said application server thereafter determining that it is not required in said signal path to complete call setup and removing itself from the call signaling path. (*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager can remove itself from the communication path")

As to **claim 7**, *Celi* further disclose(s) a method wherein said step of removing occurs prior to completion of call setup. (*Celi*; col. 8, ll. 9; call engine can terminate involvement during "call setup functions")

As to **claim 8**, *Celi* disclose(s) signaling method for use in setting up internet protocol network calls, wherein said internet protocol network comprises an application server for providing call feature processing, said method comprising the steps of:

receiving at an application server (*Celi*; Fig. 1; 105; Connection Server) a request (*Celi*; Fig. 4; call information request) for call feature processing for a call whereby said request inserts said application server in a signaling path for call setup; (*Celi*; col. 8; ll. 12; communication path)

said application server providing said call feature processing. (connection server provides processing services through telephony resources 120 and 125; col. 4, ll. 4-16)

Celi do(es) not expressly disclose call feature processing including determining a primary and alternate routing number for said calls.

Lewis disclose(s) determining primary and alternate destinations for a call. (*Lewis*; [0053])

Celi and *Lewis* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the alternate destination aspect of *Lewis* with the method of *Celi*. The suggestion/motivation would have been to notify someone of an incoming call even if his/her primary address is busy. (*Lewis*; [0053])

Celi further discloses said application server removing itself from said signaling path upon a determination that it is no longer required in said signaling path for call setup. (*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager can remove itself from the communication path")

As to **claim 9**, *Celi* disclose(s) a method wherein said step of removing occurs prior to completion of call setup. (*Celi*; col. 8, ll. 9; call engine can terminate involvement during "call setup functions")

As to **claim 11**, *Celi* do(es) not expressly disclose a method wherein said step of removing occurs immediately subsequent to said determining step.

Celi does disclose(s) removing a connection manager once the manager is no longer needed in the connection path. (*Celi*; col. 8; ll. 12) *Lewis* discloses a

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connection manager that handles alternate destinations. (*Lewis*; [0053])

Combining the connection manager of *Celi* with the one in *Lewis* would be obvious to remove the connection only after the alternate destination is handled.

Celi and *Lewis* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the connection manger of *Celi* with the connection manager of *Lewis*. The suggestion/motivation would have been to notify someone of an incoming call even is his/her primary address is busy. (*Lewis*; [0053])

As to **claim 12**, *Lewis* and *Celi* further discloses a method wherein said step of providing said call feature processing further comprises the steps of:

sending said primary routing number to a network element; (*Lewis*; [0053]; the routing info is sent to the service control point or SCP, which is an element on the network)

receiving an indication for the alternate routing number; and(*Lewis*; [0054]; the service profile specifies alternate destinations)

As to **claim 13**, *Lewis* and *Celi* further disclose(s) a method wherein said step of removing occurs immediately subsequent to said step of determining said alternate routing number. (*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager can remove itself from the communication path")

See similar motivation to claim 11.

As to **claim 14**, *Celi* disclose(s) a network node for providing call feature processing during setup of internet

protocol network calls, said network node (*Celi*; Fig. 1; 105; Connection Server) comprising of:

means for receiving call information. (*Celi*; Fig. 4; call information request)

Celi do(es) not expressly disclose means for providing call feature processing including determining a primary and alternate routing number for said call.

Lewis disclose(s) determining primary and alternate destinations for a call. (*Lewis*; [0053])

Celi and *Lewis* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the alternate destination aspect of *Lewis* with the method of *Celi*. The suggestion/motivation would have been to notify someone of an incoming call even if his/her primary address is busy. (*Lewis*; [0053])

Celi further discloses means for determining whether said network node is required in a signaling path to complete call setup for said call; and(*Celi*; Fig. 4; Step 460; if more resource need to be queried then the connection manager repeats the determination process as needed)

means for said network node removing itself from the signaling path if is not required in the signaling path to complete said call setup. (*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager can remove itself from the communication path")

5. **Claim(s) 2, 5, 6 and 15** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,406,168 B2 to *Celi, JR. et al.* ("*Celi*") in view of U.S. Pre-Grant Publication 2002/0194331 A1 to *Lewis et al.* ("*Lewis*") and in further view of "RFC3261: SIP Session Initiation Protocol" to *Rosenberg et al.* ("*RFC3261*").

As to **claim 2**, *Celi* do(es) not expressly disclose a method wherein said step of said application server removing itself from the call signaling path further comprises the step of:

transmitting an SIP REDIRECT message to a call control element (*Celi*; *SIP Proxy*; 360; Fig. 3).

RFC3261 disclose(s) using SIP REDIRECT Messages to remove a SIP network entity from a call path. (*RFC3261*; p. 51; taking a server out of loop)

Celi and *RFC3261* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the REDIRECT aspect of *RFC3261* with the method of *Celi*. The suggestion/motivation would have been to reduce the processing load, i.e. increase efficiency. (*RFC3261*; p. 51; "reduce the processing load")

As to **claim 5**, *Celi* do(es) not expressly disclose a method wherein:
said step of said application server providing said feature processing
further comprises the step of sending an SIP INVITE message to a call control
element (*Celi*; *SIP Proxy*; 360; Fig. 3) in order to invoke service of another
network server; and

RFC3261 disclose(s) using SIP INVITE messages to establishing
connection between SIP participants. (*RFC3261*; p. 20; "the INVITE method")

Celi and *RFC3261* are analogous art because they are from the same
field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of
ordinary skill in the art to combine the INVITE aspect of *RFC3261* with the
method of *Celi*. The suggestion/motivation would have been to use a standard
method of connecting SIP participants. (*RFC3261*; p. 20; "the INVITE method")

Celi also do(es) not expressly disclose said step of said application server
removing itself from the call signaling path further comprises the steps of sending
to said call control element a) an SIP redirect message or SIP REFER message,
and b) an SIP cancel to cancel said INVITE message.

RFC3261 disclose(s) canceling SIP INVITE messages. (*RFC3261*; p. 114;
CANCEL request)

Celi and *RFC3261* are analogous art because they are from the same
field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the canceling aspect of *RFC3261* with the method of *Celi*. The suggestion/motivation would have been to cancel the invitation in a standard manner. (*RFC3261*; p. 114; CANCEL request)

As to **claim 6**, *Celi* further disclose(s) a method wherein said another network server is a media server and wherein said invoked service is collection of caller input. (*Celi*; Fig. 1; Application Platforms 120 & 125; provide call processing services – wherein “voice response services” teach caller input.)

As to **claim 15**, *RFC3261* disclose(s) a network node wherein said means for removing further comprises:

means for transmitting an SIP redirect message to a call control element.

See similar rejection and motivation to claim 2, where the node is taught by the method of 2.

As to **claim 17**, *RFC3261* further discloses, wherein the call control element sends another SIP INVITE message to the other network server; and

The other network server determines the IP address of the alternate routing number. (*RFC3261*; p. 14; discloses sending an SIP INVITE through two proxy servers to a SIP client)

RFC3261 disclose(s).

Lewis and *RFC3261* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the SIP INVITE aspect of *RFC3261* with the alternate number of *Lewis*. The suggestion/motivation would have been to initiate a call to the alternate number in a manner consistent with SIP. (*RFC3261*; p. 14)

6. **Claim(s) 3 and 16** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,406,168 B2 to *Celi, JR. et al.* ("*Celi*") in view of U.S. Pre-Grant Publication 2002/0194331 A1 to *Lewis et al.* ("*Lewis*") and in further view of "RFC3515: The Session Initiation Protocol (SIP) Refer Method" to *Sparks* ("*RFC3515*").

As to **claim 3**, *Celi* do(es) not expressly disclose a method wherein said step of said application server removing itself from the call signaling path further comprises the step of:

transmitting an SIP REFER message to a call control element.

RFC3515 disclose(s) using SIP REFER messages to refer a SIP participant to a SIP resource. (*RFC3515*; p. 1)

RFC3515 and *Celi* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the REFER aspect of *RFC3515* with the method of *Celi*. The suggestion/motivation would have been to enable features such as call transfers. (*RFC3515*; p. 2)

As to **claim 16**, *RFC3515* disclose(s) a network node wherein means for removing further comprises:

means for transmitting an SIP REFER message to a call control element.

See similar rejection and motivation to claim 3, where the node is taught by the method of 3.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN LEE whose telephone number is (571)270-5606. The examiner can normally be reached on 9/4/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. L./
Examiner, Art Unit 2445

/VIVEK SRIVASTAVA/
Supervisory Patent Examiner, Art Unit 2445